

### Remarks

After amendment, newly added claims 39-73 remain pending in the present application after canceling all previously pending claims. Applicant submits this preliminary amendment in conjunction with the filing of the enclosed Request for Continued Examination (RCE) in order to present claims which are directed generally to methods of treatment which make use of the disclosed compounds' unexpected activity as it relates to their Selective Estrogen Receptor Modulator (SERM) activity.

Applicant respectfully submits that the presently pending claims are patentable over the prior art cited of record, inasmuch as that art is relied upon by the Examiner for the teaching of *exclusively estrogenic activity* of the disclosed compounds, not SERM activity as in the present method. There is simply no teaching or motivation of the methods of the present invention which rely on the unexpected SERM activity. Thus, according to the methods of the present invention, SERM compounds may be used to treat estrogen-sensitive cancers, to reduce the likelihood of the recurrence of estrogen-sensitive cancers and to treat menopausal symptoms without increasing the risk of or exacerbating estrogen-sensitive cancers in the treated patient. The prior art neither discloses nor suggests the methods of the present invention inasmuch the teachings there involve the putative exclusive estrogenic activity of the disclosed compounds. It is respectfully submitted that compounds of the prior art which are presumed (incorrectly) to exhibit exclusively estrogenic activity would not be understood to be useful in the methods of the present invention which are counterintuitive to the prior art teachings. Indeed it is the unexpected activity of the present compounds as *SERMS* which provides the basis of the invention of the present application.

It is noted that because the compounds which are used in the present invention exhibit selective estrogenic activity (agonist activity at certain receptors and antagonist activity at other receptors), the methods of the present invention are reflective of that selective estrogenic activity. Thus, in the present invention, recognition of this unexpected SERM activity gives rise to a method for treating estrogen-sensitive cancers, a method for treating menopausal symptoms in a patient who also is stricken with an estrogen-sensitive cancer and the other methods as claimed.

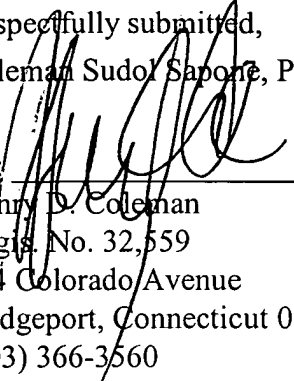
It is clear that the prior art does not disclose these methods and it is also clear that the prior art, which teaches the exclusive (desirable) estrogenic activity of the disclosed compounds does not suggest or motivate one of ordinary skill in the art to practice the presently claimed methods. Indeed, if anything, the prior art *teaches away* from the present invention inasmuch as compounds which are disclosed in the prior art as exhibiting *exclusively* estrogenic activity would not be used in the methods of the present application which are directed to the unexpected SERM activity of compounds which are claimed in the present methods. There was no suggestion or even an oblique reference to the invention of the present application, nor was there motivation to practice the present method from the prior art disclosure.

For the above reasons, Applicant respectfully asserts that the claims set forth in the amendment to the application of the present invention are now in compliance with 35 U.S.C. Applicants respectfully submit that the present application is now in condition for allowance and such action is earnestly solicited. Applicants have neither cancelled nor added any claim to the present application.

35 claims (4 independent) have been added to the present application pursuant to the presentation of this preliminary amendment. 38 claims have been canceled (2 independent). A fee in the amount of \$100 for the additional independent claim (beyond 3 independent) is enclosed. Small entity status pertains to the present application. A supplemental information disclosure statement is enclosed as is a petition for a one month extension of time and appropriate fees. If any additional fee is due or any overpayment has been made, please charge/credit Deposit Account No. 04-0838.

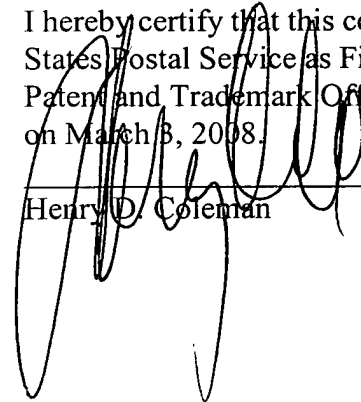
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Respectfully submitted,  
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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: "United States Patent and Trademark Office P.O. Box 1450 Alexandria, Virginia 22313-1450" on March 3, 2008.

  
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